

Notice of Allowability

Application No.

09/514,699

Examiner

Janis L. Dote

Applicant(s)

ZHAO ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/14/04 and 3/8/04.
2. ☒ The allowed claim(s) is/are 1,3-5,7 and 9.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date OF 8/19/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

1. The examiner acknowledges the amendment to claim 1 and the cancellation of claims 10-20 filed on Mar. 8, 2004.

Claims 1, 3-5, 7, and 9 are pending.

2. The "Amendment to the specification" filed on Mar. 8, 2004, was not in compliance with 37 CFR 1.121 for the reasons discussed in the "Notice of Non-compliant Amendment" mailed on May 25, 2004. The "Amendment to the specification" filed on Mar. 8, 2004, has not been entered.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Richard M. Klein (Reg. No. 33,000) on Aug. 9, 2004.

The application has been amended as follows:

In the amended paragraph beginning at page 1, line 9, of the specification, filed on Jun. 14, 2004, line 4 of the

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amended paragraph, after the phrase "filed November 30, 1998," insert the phrase -- now U.S. Patent No. 5,989,769, --;

In the amended paragraph beginning at page 1, line 9, of the specification, filed on Jun. 14, 2004, line 6 of the amended paragraph, after the phrase "filed August 30, 1999," insert the phrase -- now U.S. Patent No. 6,060,204, --;

At page 20, line 6, delete the term "Sweco Mill" and insert the term -- SWEKO MILL --; and

At page 27, line 16, delete the term "Solsperse" and insert - SOLSPERSE --.

4. The examiner's amendment set forth in paragraph 3, supra, to the amended paragraph beginning at page 1, line 9, of the specification, filed on Jun. 14, 2004, updates the status of the US applications cited in said paragraph.

The examiner's amendments to pages 20 and 27 of the specification capitalize the trademarks disclosed at said pages.

REASONS FOR ALLOWANCE

5. The following is an examiner's statement of reasons for allowance:

The objection to the specification set forth in the Final rejection mailed on Dec. 21, 2001 (CTFR122101), paragraph 5, has been withdrawn in response to the amended paragraphs beginning at page 26, line 14, and page 27, line 1, of the specification, filed on Jun. 14, 2004, and the examiner's amendment at pages 20 and 27 set forth in paragraph 3, supra.

The rejection of claim 10 under 35 U.S.C. 112, second paragraph, made under 37 C.F.R. 1.196(b), as set forth in the decision by the Board of Patent Appeals and Interference (BPAI) mailed on Oct. 21, 2003, has been withdrawn in response to the cancellation of claim 10, and the amendment to claim 1 filed on Mar. 8, 2004. The amendment to claim 1 adds the limitation that the "the reclaimed undeveloped developer cake is kept separated from the second liquid developer until the solids content of the second liquid developer drops below from about 6 to about 10 weight percent" (emphasis added). The recitation of the phrase "kept separated" was suggested by the BPAI to avoid

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the 112, second paragraph rejection. See the decision, page 11, last full paragraph.

The rejections under 35 U.S.C. 103(a) of claims 1, 4, 5, 7, and 9 over US 5,345,296 (Wellings) combined with US 5,254,427 (Lane), as evidenced by the EXXON product information bulletins for ISOPAR G and H, and of claims 1, 3-5, 7, and 9 over US 5,826,147 (Liu'147) combined with Wellings and Lane, as evidenced by the EXXON product information bulletins for ISOPAR G and H, as set forth in CTFR122101, paragraphs 11 and 12, have been withdrawn in response to the amendment to claim 1 as described supra. As discussed in the rejections, Wellings and Liu both teach returning reclaimed unused liquid developer to the working developer. Wellings, col. 5, lines 2-4, and Fig. 1, reference label 23 and 24; and Liu, col. 13, lines 7-15. However, neither Wellings nor Liu nor the other cited prior art teaches or suggests a process wherein the "reclaimed undeveloped developer cake kept separated from the second liquid developer until the solids content of the second liquid developer drops below about 6 to about 10 weight percent" (emphasis added), as recited in instant claim 1.

Claims 1, 3-5, 7, and 9 are allowable over the prior art of record for the reasons discussed supra.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD
Aug. 9, 2004

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